## III. Remarks

Applicant has amended independent claims 1 to further clarify what is meant by "solution- independent intermediate format", devoid of said particulars unique to the "originating software, hardware, and operating system". This language removes the issues raised by the Examiner and is consistent with other claims and the specification as indicated below. No new matter is presented. Claim 20 is amended to correct a word processing error discovered by Applicant. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Final Office Action mailed March 20, 2007 and responds in detail below. Reconsideration of the application is respectfully requested.

Claims 1-38, and in particular independent claims 1 and 20 stand rejected under 35USC 112. These rejections are traversed on the following grounds.

It is the nature of the system and method of this application, that an original book file be established as a starting point. In the Background of Related Art section of this application, it is stated as follows:

**"One noticeable problem with prior art print-on-demand book publishing methods is that while master book files created by one particular publisher/content provider can be efficiently reproduced as books by the same entity because the software has been designed for the particular needs of the content provider, the master book files may not be efficiently reproduced by another entity." (page 1, line 24 to page 2, line 3)**

This starting point is referred to, as an "original" master book file, and, therefore, must be created, by an originator or original content provider. This is evident throughout the application. The Examiner's attention is directed to, for example, page 2, line 6 and in particular block 104 of figure 4. The original master book file is stated to have software

characteristics "designed for the particular needs of the content provider". This content provider constitutes the originator. A person skilled in the art would understand that such software characteristics would accurately include, "a digital structure and codes of an originating software, hardware, and operating system" and further that such digital structure and codes of an originating software, hardware, and operating system, may also include particulars "unique to the originating software, hardware, and operating system". It is these particulars that hinder the use of the original master book file by subsequent publishing entities.

Applicant has further amended the claims for consistency and to avoid what appears to be confusion on the part of the Examiner with respect to the clear meaning of the specification. It is submitted that the reference to "Administrator of the system" refers to the administrator of the system ***of the original content provider.***

Applicant submits that this amendment fully remedies the basis for the rejection based on 35USC112.

Applicant has amended the claims to clarify the novel features of the invention for which protection is sought in this application in response to Examiner's comments. In particular the claims are amended in response to the rejection under 35USC112 and to support Applicant's arguments distinguishing the cited reference Dodge. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. Applicant submits that such amendments are properly entered under 37USC1.116. The Examiner is respectfully requested to enter these amendments in order to advance the prosecution of this application.

In rejecting the claims, the examiner has cited, for the first time, the reference Dodge as a basis for new obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments, but the acknowledgement by the

Examiner of the deficiencies of the reference Warmus. Accordingly, the issuing of a final rejection is improper under MPEP section 706.07(c) where it is stated:


**"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."**

The Examiner is respectfully requested to reconsider the final nature of the pending office action and his rejection in view of the above amendments and the following arguments. The entering of the above amendments will permit the clarification of the issues for appeal or the allowance of the claims.

Claims 1-3, 9-22, and 28-30 are rejected under 35 USC 103(a) based on the combined teaching of the reference Warmus (US Pat. No. 6,332,149) in view of the newly cited reference Dodge (US Pat. No. 5,655,130.) The Examiner is respectfully requested to reconsider the rejection in view of the above amendments and the following remarks. This rejection is traversed on the following grounds:

The combined teaching of Warmus and Dodge does not render Claims 1-3, 9-22, and 28-30 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) *In re Vaeck*, **947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the claimed features of independent claims 1 and 20 as stated below:

in claim 1:

"b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the originating software, hardware, and operating system;

c) storing said solution-independent, intermediate formatted book file along with book identification information as a mastered book;

d) converting said solution-independent, intermediate formatted book file to a solution-dependent formatted book file to match the needs of a particular book reproduction system;"

and in claim 20:

a book file generator adapted to generate a digital representation with a digital structure and codes of an originating software, hardware, and operating system of a book targeted for reproduction, said representation being a complete book file, including a book block;

a solution-independent converter adapted to convert said complete book file to have a solution-independent, intermediate format, in a universal format, devoid of said digital structure and codes of the originating software, hardware, and operating system;

a book file memory adapted to store said solution-independent, intermediate formatted book file along with book identification information as a mastered book;

a solution-dependent converter adapted to convert said solution-independent, intermediate formatted book file to a solution-dependent formatted book files to match the needs of a particular book reproduction workflow utilized;

The Examiner acknowledges that the reference Warmus fails to disclose:

"converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator digital structure and codes of an originating software, hardware, and operating system."

This statement appears to be in conflict with the statement in the last paragraph on page 5 of the Office Action, it is assumed that the conflicting paragraph is an artifact of earlier office actions and was meant to be deleted.

The Examiner continues to indicate that the files of Warmus start with an original file wherein "said original digital structure and codes includes particulars   unique to the needs of the originator".   This is an assumption by the Examiner, as there is nothing in Warmus that states this.  This is because the original digital structure is irrelevant to the purpose of Warmus.  Warmus is directed only to textual content.  This assumption is an effort by the Examiner to support the impression that Warmus is directed to solving a problem similar to the problem to which this application is directed.  The assumption is not correct.

The problem to which Warmus is directed is a page file problem dealing with textual content and treats the textual files on a page by page basis, whereas the solution of the subject invention relates to digital platform of the entire book file.  Warmus results in the customization of individual pages of a book during printing of multiple copies.  In the system of this invention, all of the pages are processed in the same manner, with respect to content, while the entire book file may be transferred and converted to accommodate solution, or platform, or device dependent needs of a particular publisher.

The nature of the stripped working files of Warmus is explained at column 11, lines 10-29, as follows:

> "A further set of working files is stripped of all fixed
> information to create stripped variable page files 126
> defining template pages having fixed information removed
> therefrom and further having the area data defining the      areas
> 110, 112. The data representing template pages having  variable
> information thereon are expanded into a set of   intermediate      page
> files. In the example of FIGS. 6a and 6b   and   under   the   assumption
> that three books are to be printed, two intermediate page files 130,
> 132 are thus    produced. The file 130 includes a file portion P1-a

```
      defining the position of variable information to be    produced
on the page P1 for the first book. Two other file         portions    P1-b
and P1-c define the position of variable   information to be produced
on the front outside covers of  the  remaining  two  books.  In  like
fashion, file portions P4- a, P4-b and P4-c represent the position of
variable   information to be reproduced on the back outside covers of
      the three books. At this point, data is also contained in   each
of the files 130, 132 identifying the entries in the   database  108  to
be placed in the areas 110, 112 during       printing.
```

There is no reference to changing digital structure and codes of an originating software, hardware, and operating system. The processing of the page files of Warmus causes an entirely different result than the processing of the book files in this application. The reference Warmus designates a fixed text file and variable text files wherein the variable text file may be altered. It relates to text files not digital structure and codes.

The deficiencies of the teaching of Warmus are therefore greater than the Examiner indicates and these deficiencies are not remedy by the teaching of Dodge.

The Examiner has now cited the reference Dodge. Dodge teaches that, by using object oriented information management methods, a document database may be partitioned into a number of encapsulated data elements, that are classified and tagged. The document database may then be filtered and formatted to form variation specific documents (see column 4, lines 8-29 and figure 2 of Dodge).

The document database is a compilation of documents suitable for different platforms. It, therefore, contains all of the software and digital codes of the originating content provider including any particulars unique to the originator and further includes all of the digital structures for other possible platforms (see column 6, lines 43-56). It does not covert an original, master book file into a solution independent intermediate format, but instead creates a database in which elements of the book information are identified, tagged and classified to enable the compilation of different versions of the book file suitable for a particular platform. This is the opposite of the stripped down book file

into which the master book file of this application is converted. The book file is described at column 7, lines 21-32, as follows:

> "An information data model is a conceptual aid used to
> describe information stored in a database. In the CDS
> information data model, the data for a particular document  is
> stored in a database as encapsulated data elements. An
> encapsulated data element is an object that contains two   kinds
> of information: 1) The information itself (such as an  actual
> paragraph, table, or graphic), and 2) Classifying      data about  that
> information, including its structure (such  as  the  fact  that  it  is  a
> paragraph structure or table     structure)    and    which    class    or
> variation the information   applies    to.    These   encapsulated   data
> elements can then be  combined   in   a   number   of   variation-specific
> documents."

Dodge, therfore, fails to teach the elements of the claims identified above. Dodge fails to remedy the deficiencies of Warmus. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Warmus and Dodge, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.
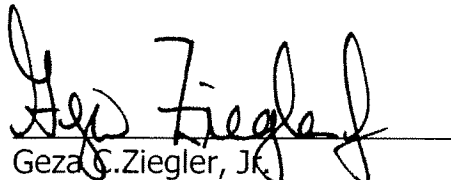
For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

Respectfully submitted,
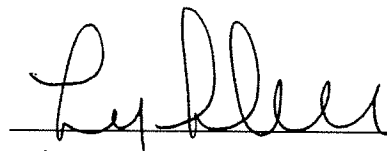
Geza C. Ziegler, Jr.
Reg. No. 44,004

22 AUGUST 2007
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT  06824
(203) 259-1800
Customer No.: 2512

## CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted electronically, on the date indicated below, addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA  22313-1450.

Date: 22 August 2007      Signature: 

Lisa Shimizu
Person Making Deposit